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Applicant : Dwight Allen Merriman et al. Art Unit : 3714
Serial No. : 09/577,798 Examiner : Ronald Lancau
Filed : May 24, 2000


Title : Method of Delivery of Targeting, and Measuring Advertising Over Networks

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

A copy of the appeal brief filed September 29, 2003 with annotated claims is attached.

Respectfully submitted,

Date: March 9, 2009


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PATENT
Att'y Dkt.: =11032/2144

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MERRIMAN, Dwight et al.

Examiner: J. Harle

Reissue Serial No.: 09/577,798

Patent No. 5,948,061, Issued September 7, 1999

Art Unit: 3627

Reissue Filed: May 24, 2000

For: METHOD OF DELIVERING, TARGETING,
AND MEASURING ADVERTISING OVER
NETWORKS

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GROUP 3600

TRANSMITTAL OF APPEAL BRIEF UNDER 37 CFR 1.192Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

Attached hereto, in triplicate, is Appellants' Brief under 37 CFR § 1.192, for the above-referenced application. The Commissioner is authorized to charge the requisite fee \$320.00 (37 CFR 1.17(c)) and all other fees associated with this submission to Deposit Account No. 11-0600. A duplicate copy of this sheet is attached hereto.

Respectfully submitted,

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Reissue Patent
Atty. Docket No. 11032-2144

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re application of:

MERRIMAN, Dwight et al.

Reissue Serial No.: 09/577,798

Patent No. 5,948,061, Issued September 7, 1999

Reissue Filed: May 24, 2000

For: METHOD OF DELIVERING, TARGETING, AND
MEASURING ADVERTISING OVER NETWORKS

Examiner: J. HARLE

Art Unit: 3627

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences**RECEIVED**

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GROUP 3600

Sir:

Applicants submit this appeal brief in the above-referenced reissue application. A notice of appeal was filed on April 28, 2003, and the attached Petition For Extension of Time extends the due date through September 29, 2003 (September 28, 2003 falling on a Sunday).

REAL PARTY IN INTEREST

DoubleClick Inc. is the real party in interest for all issues related to this application by virtue of an assignment recorded with the Office.

RELATED APPEALS OR INTERFERENCES

An Appeal Brief was filed on May 13, 2003 in application no. 09/094,949, which includes similar subject matter. A Rule 607 Notice of Attempt to Provoke Interference was mailed March 10, 2003 for U.S. Pat 5,948,061 (issued September 7, 1999), which also includes similar subject matter.

PATENT
ATTY. DOCKET NO. 11032-2144

STATUS OF CLAIMS

This application contains claims 1-57, all of which stand finally rejected. All rejections are appealed.

STATUS OF AMENDMENTS

No Amendment After Final Rejection was filed in this application.

SUMMARY OF THE INVENTION

Embodiments of the present invention include a network 10, which includes affiliate web site 12, an advertisement server or web site 19, and one or more individual advertiser's servers or web sites 18. When a user using a browser accesses or visits an affiliate web site 12, an advertisement provided by advertisement server 19 is superimposed on the display of the affiliates web page displayed by the user's browser. See Fig. 1 and col. 2, l. 59 through col. 3, l. 4. The computers supporting the browser, the affiliate web site 12 and the advertisement server 19 are normally entirely different nodes on the Internet. See col. 3, l. 16-18. Upon selecting the advertisement, the browser is connected to the advertiser's server or web site 18 for that advertisement. See col. 3, l. 18-23.

In further detail, the affiliate web site 12, in response to the request 20 from the user, sends back one or more hypertext transfer protocol messages. The messages contain the information available at web site 12 for the requested page to be displayed at the user's browser 16. The affiliate's web server 12 also sends a link including an IP address for an advertisement server 19. The advertisement server 19 determines which advertisement to provide to the user's browser for display. See col. 3, l. 24-63.

Figure 2 illustrates the advertisement server 19 architecture. The advertisement server 19 uses a database 54. The database 54 performs profile process 52 to gather information about individual users. Advertisements are stored within the advertisement server 19. See col. 4, l. 20-30.

PATENT
ATTY. DOCKET NO. 11032-2144

For each user identified by the system, a user identification, IP address, domain name, time zone, location of the user, standard industrial code for the user's network, the particular advertisements seen and the number of times seen, the advertisements that were selected or "clicked on" and the pages on which the various users' advertisements were seen is collected. Use of the information allows targeted advertising. The advertisement server 19 obtains from the database all the information known about the user, and calculates the relative time of day for the user. A table of targeting profile criteria for the advertisement is used along with the information about the user to select advertisements. If two or more advertisements are selected, it is determined how many times the user has been exposed to the advertisement, and if that number is below a predetermined threshold, the advertisement is retained as a possible match. Matches may then be used to select a particular advertisement. See col. 4, l. 44- col. 6, l. 59.

ISSUES

- A. Whether claims 1, 3, 7, 9, 13, 16, 20, 23, 25, 32, 35-36, 42, 45 and 47 are anticipated under 35 U.S.C. §102(e) by U.S. Pat. 5,740,549 to Reilly et al. (hereinafter "Reilly").¹
- B. Whether claims 1-57 are anticipated under 35 U.S.C. §102(b) by "FocaLink's public use of centralized ad serving technology" in view of LinkMarket's Business Brochure (DX 56), FocaLink's Business Brochure (DX 57), LinkMarket Business Plan (DX 89), FocaLink Press Release titled "Hyperlink Advertising Explodes on the World Wide Web" (DX 90), FocaLink Media Services, Inc. (DX 215), and the depositions of Ron Kovas and David Zinman (hereinafter "FocaLink").

¹ In addressing Reilly in the Final Rejection, the Examiner states that "the rejection of claims 1-57 is maintained and made final." Oct. 28, 2002 Office Action at 5. However, the preceding Office Action (dated Oct. 24, 2001) only rejected certain claims based on Reilly, namely, claims 1, 3, 7, 9, 13, 16, 20, 23, 25, 32, 35-36, 42, 45 and 47. Claims 2, 4-6, 8, 10-12, 14-15, 17-19, 21-22, 24, 26-31, 33-34, 37-41, 43-44, 46, and 48-57 were *not* rejected in the Oct. 24, 2001 Office Action based on Reilly, and therefore Applicants' position is that this latter group of claims do not stand rejected under Reilly.

PATENT
ATTY. DOCKET NO. 11032-2144

- C. Whether claims 1-57 are invalid under 35 U.S.C. §102(b) based on an alleged sale of the claimed invention more than one year prior to the filing date of the '061 patent (which is the subject of the present reissue application).

GROUPING OF CLAIMS

Group I: claims 1-50.

Group II: claims 51-57.

Separate reasons for patentability for each group are set forth below.

ARGUMENT

Summary of Argument

None of the claims of the present reissue application are anticipated by Reilly. Reilly does not disclose an advertisement server node storing information about a user node, the advertisement server node being responsive to a request from the user node based on a link message to select an advertiser node as a selected advertiser node based on information about the user node at the advertisement server node, as required by the independent claims 1, 7, 13, 16, 23, and 32, or the corresponding recitations in method claims 42, 45 and 47 of an advertisement server node storing information about a user node, and selecting, at the advertisement server node, an advertiser node based on the information stored about the user node.

None of the claims of the present reissue application are anticipated by FocaLink. FocaLink does not disclose: 1) a system or method for selecting an advertiser node or advertising banner based upon information stored about the user node at the advertisement server node, as required by independent claims 1, 7, 13, 16, 23, 29, 32, 42, and 45; or 2) a system or method wherein the advertisement server node selects an advertiser node or advertising banner based on a number of times the advertising

PATENT
ATTY. DOCKET NO. 11032-2144

content has been previously displayed at the user node, as required by independent claims 51-57.

The claimed invention was not on sale more than one year prior to the filing date of the '061 patent. First, the claimed invention was not the subject of a commercial offer for sale prior to the critical date; rather, the transaction at issue was initiated after the critical date and was primarily for experimental purposes. Second, the claimed invention was not ready for patenting prior to the critical date; indeed, the invention was still in the experimental phase for several months after the critical date.

A. The Claims Are Not Anticipated By Reilly

Reilly discloses an information and advertising distribution system. An information server stores and updates a database of information items and advertisements, with the information items and advertisements each categorized so that each has an associated information category. An advertisement is displayed on a subscribers' workstation simultaneously with news items assigned to the same category as the advertisement. See col. 3, l. 66 through col. 5, l. 7.

The information database includes advertising display statistics 148 and news item display statistics 149, which are collected from subscribers' computers. The advertising display statistics indicate how many times each advertisement has been displayed on subscribers' computers. See col. 5, l. 61 through col. 6, l. 10.

The Examiner's position regarding how disclosures of Reilly allegedly read on claim 1 of the '061 reissue patent, as set forth in the October 24, 2001 Office Action, is that news story items of Reilly correspond to the claimed content provider node, that advertisements of Reilly correspond to the claimed advertiser node, and that Reilly's advertising display statistics and display scripts correspond to the claimed advertisement server node storing information about said user node, said advertisement server node being responsive to a request from said server node based on said link message to select an advertiser node as a selected advertiser node based upon the information stored about the user node at the advertisement server node, and identify said advertiser node as said selected advertiser node to said user node. Regarding the

PATENT
ATTY. DOCKET NO. 11032-2144

advertising display statistics and display scripts, the Examiner refers to cols. 5-6, lines 61-34. See Office Action dated October 24, 2001, pp. 13-14.²

However, Reilly does not disclose that the advertising display statistics or display scripts (asserted by the Examiner to be equivalent to the advertisement server node storing information about the user node) are used to select an advertiser node (or advertisement) as required by the rejected claims. Instead, the advertising display statistics indicate how many times each advertisement has been displayed (see col. 5, l. 61 through col. 6, l. 6) and the display scripts control how the news stories and advertisements are displayed, by controlling the number, position, movement of news items and advertisements (see col. 5, l. 24-34).

In fact, Reilly discloses that the advertisement shown is selected on the basis of the information category associated with the news item being viewed, not based on advertising display statistics or display scripts as suggested by the Examiner. Reilly selects the advertisements in rotating order among the advertisements assigned to each information category. Reilly indicates that the advertisement is changed every time the subscriber clicks on a category button to select a different information category than the one previously selected, and every 30 seconds when the subscriber continues to view items in a single news category. See col. 13, l. 62 through col. 14, l. 6.

Accordingly, Reilly does not disclose selecting an advertiser node as a selected advertiser node based on information stored about the user node at the advertisement server node, as required by independent claims 1, 7, and 13, and corresponding dependent claims 3 and 9. Likewise, Reilly does not disclose the corresponding recitations in method claim 45 (and corresponding dependent claim 47) of selecting, at the advertisement server node, an advertiser node based on the information stored about the user node at the advertisement server node. Similarly, Reilly does not disclose selecting an advertisement banner based on information stored about the user node at the advertisement server node, as required by independent claims 16, 23, 32, and 42,

² The October 24, 2001 Office Action is referred to because the details of the Examiner's rejection are not set forth in the Final Rejection.

PATENT
ATTY. DOCKET NO. 11032-2144

and corresponding dependent claims 20, 25, and 35-36. Therefore, it is requested that the rejection of the claims as anticipated by Reilly be overturned.

B. The Claims Are Not Anticipated By Focalink

FocaLink does not disclose: 1) a system or method for selecting an advertiser node or advertising banner based upon information stored about the user node at the advertisement server node, as required by independent claims 1, 7, 13, 16, 23, 29, 32, 42, and 45; or 2) a system or method wherein the advertisement server node selects an advertiser node or advertising banner based on a number of times the advertising content has been previously displayed at the user node, as required by independent claims 51-57.

The Examiner asserts that SmartBanner technology stores information based on the domain name of the user and targets from there, and that DX 93 stores "post-buy" information – demographics of those who view or click on an advertisement and the number of people who view/click on an advertisement. See Final Rejection, pp. 9-10. However, the various FocaLink references do not disclose that such information is stored, or that stored information about a user node is used to select an advertising node or an advertising banner, as required by claims 1-50. Rather, the FocaLink references disclose that such "post-buy" information is used to generate reports provided to advertisers and web sites. Accordingly, claims 1-50 are not anticipated by FocaLink.

Regarding claims 51-57, the Examiner has not even asserted that FocaLink discloses selecting an advertiser node or advertising banner based on a number of times the advertising content has been previously displayed at the user node. While the Examiner asserts that DX93 discloses use of the number of people per day who view/click on an advertisement (see Final Rejection, page 9), this is not selecting an advertiser node or advertising banner based on a number of times the advertising content has been previously displayed at the user node, as recited in claims 51-57. To the contrary, as discussed above, the FocaLink references disclose that any such "post-buy" information is used to generate reports provided to advertisers and web sites. Furthermore, the number of people per day who view/click on an advertisement can be very different than the number of times the advertising content has been previously

PATENT
ATTY. DOCKET NO. 11032-2144

displayed at the user node. FocaLink's use of the number of people per day who view/click on an advertisement thus could be related to any number of user nodes, while claims 51-57 relate to the number of times the advertising content has been previously displayed at a particular user node. Accordingly, claims 51-57 are not anticipated by FocaLink.

C. The Claimed Invention Was Not On Sale More Than One Year Prior to The Filing Date

The Examiner has rejected claims 1-57 under 35 U.S.C. §102(b) based upon an alleged sale of the claimed invention more than one year prior to the filing date of the application that eventually matured into the '061 patent.³ Applicants respectfully traverse this rejection and submit that the claimed invention does not fall under the on-sale bar of §102(b).

The Supreme Court has established a two-part test for determining whether an invention is subject to the on-sale bar under §102(b). In order for the on-sale bar to apply, (1) the invention must be the subject of a commercial offer for sale, and (2) the invention must be ready for patenting. *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 67, 119 S. Ct. 304, 311-12, 48 U.S.P.Q.2d 1641, 1646-47 (1998). In the absence of either of these prongs, the on-sale bar does not apply.

1. No Commercial Offer For Sale Was Made Prior To The Critical Date

The events that took place prior to the critical date do not constitute a commercial offer for sale under §102(b). Under the standard established by the Federal Circuit, a commercial offer for sale sufficient to trigger §102(b) requires a firm and complete offer: "Only an offer which rises to the level of a commercial offer for sale, one by which the other party could make into a binding contract by simple acceptance (assuming consideration), constitutes an offer for sale under §102(b)." *Group One Ltd. v. Hallmark Cards Inc.*, 254 F.3d 1041, 1048, 59 U.S.P.Q.2d 1121, 1126 (Fed. Cir. 2001) (emphasis

³ The application that matured into the '061 patent (that is the subject of this reissue application) was filed on October 29, 1996, making October 29, 1995 (one year prior) the "critical date" for purposes herein.

PATENT
ATTY. DOCKET NO. 11032-2144

added). In the *Group One* ruling, the Federal Circuit rejected the proposition, based upon dictum in a prior decision, that something less than a formal offer under contract law principles would suffice to trigger the on-sale bar. *Group One*, 254 F.3d at 1046-47, 59 U.S.P.Q.2d at 1125. The Court in *Group One* held that the indefinite nature of communications (letter, meeting and telephone call discussing the patented machine and technology) and the lack of specific terms (such as price and quantity) in that case did not trigger the on-sale bar. *Id.*, 254 F.3d at 1047-48, 59 U.S.P.Q.2d at 1125-26.

The transaction cited by the Examiner does not meet the standard set by the Federal Circuit for establishing a commercial offer for sale. The event relied upon by the Examiner – a single telephone call between Kevin O'Connor, one of the co-inventors of the present invention, and a colleague, Christopher Buckingham of Attachmate – lacked many terms that would be required for a "commercial" offer. Further, as discussed more fully in section C.3 below (experimental use), the transaction that ultimately occurred (after the critical date) was primarily for experimental purposes.

The telephone call between Mr. O'Connor and Mr. Buckingham took place during the last week of October, 1995 (see Declaration Under 37 C.F.R. 132 of Kevin J. O'Connor ("O'Connor R.132 Decl."), ¶ 24), just prior to the critical date of October 29, 1995.

Mr. O'Connor called Mr. Buckingham, a prior acquaintance, to discuss the general concept of targeted advertising over the Internet. O'Connor R.132 Decl., ¶ 24. During the conversation, Mr. Buckingham expressed interest in the idea and requested a proposal so that he could evaluate whether to use Mr. O'Connor's company, IAN, for Internet advertising.⁴ O'Connor R.132 Decl., ¶ 25.

After the telephone call with Mr. Buckingham, Mr. O'Connor spent a few days considering a concrete proposal to put together for Mr. Buckingham. O'Connor R.132 Decl., ¶ 26. Mr. O'Connor prepared a written proposal for Attachmate and sent the

⁴ IAN (Internet Advertising Network) was the name of the company formed by the inventors. IAN ultimately became DoubleClick Inc., the assignee of the present invention.

PATENT
ATTY. DOCKET NO. 11032-2144

proposal in a letter to Mr. Buckingham on October 30, 1995 (the "Attachmate Letter") – which was after the critical date.⁵ O'Connor R.132 Decl., ¶ 26 (and Exhibit C thereto). In the letter, Mr. O'Connor proposed that Attachmate spend \$10,000 for hard-coded nontargeted advertisements (which IAN could perform at the time) and allocate another \$10,000 for targeted advertising at a later date, when the targeted advertising software was complete and the targeting profile was determined. O'Connor R.132 Decl., ¶ 26; Attachmate Letter at pg. 1.

The single telephone discussion that preceded the critical date lacked a number of fundamental terms that would have been required to establish a binding commercial contract. Among the fundamental terms missing from the telephone discussion are the following (some of these terms were subsequently suggested, *after* the critical date, in the proposal contained in the Attachmate Letter):

- The *type of advertisements* to be provided (e.g., ads hard-coded into a web page, targeted ads to be selected and inserted real-time, or a combination of these ad types) was not specified during the telephone call. See Buckingham deposition at pg. 60.
- The Attachmate Letter proposed that IAN would provide a specified amount of non-targeted ads over a period of several months,⁶ track viewer demographics and determine the most useful user profile for targeting future ads. See Attachmate Letter, pg. 1 (numbered paragraph 2).
- The *number of ads* to be placed was not specified during the telephone call. See Buckingham deposition at pp. 42-43.
- The Attachmate Letter proposed that IAN would provide 400,000 non-targeted ads, to be followed at a later time – once the ad targeting software was completed

⁵ For the convenience of the Board, a copy of the Attachmate Letter is attached to this brief as an Exhibit.

⁶ These non-targeted ads were to be "hard-coded" into the subject web site (and thus did not use any third party ad serving technology at all). O'Connor R. 132 Decl., ¶27.

PATENT
ATTY. DOCKET NO. 11032-2144

- by targeted ads. Attachmate Letter, pg. 1 (numbered paragraph 2). However, even the letter did not specify *how many* targeted ads would be served.

- The *timeframe* over which the ads would be placed was not specified during the telephone call. See Buckingham deposition at pp. 52, 58, 61-62.
- The Attachmate Letter proposed that IAN would provided non-targeted ads over the next several months. However, the letter did not provide any specific time frame for developing and serving targeted ads, other than an indefinite reference to completion of the ad targeting software in the future. See Attachmate Letter, pg. 1 (numbered paragraphs 2, 3).
- Neither the *pricing structure* for the ads (ad rate) nor a *payment date* was specified during the telephone call.
- The Attachmate Letter proposed that IAN would determine in the future the most effective way to spend the balance for targeted ads, in accordance with favorable pricing to Attachmate (referring to a draft rate sheet having specified ad rates for targeted advertising), and that Attachmate would make a sponsorship payment by a specific due date - December 31st, 1995. See Attachmate Letter, pg. 1 (numbered paragraph 3).

In short, the absence of specific terms such as these from the prior telephone discussion confirms that there was no commercial offer to sell the invention during that conversation. See *Group One, supra* (indefinite nature of communications, and lack of specific terms such as price and quantity); *MLMC Ltd. v. Airtouch Communications, Inc.*, 215 F. Supp. 2d 464, 480 (D. Del. 2002) (no commercial offer for sale when quotations were missing terms such as delivery dates and payment terms); *D&K Int'l, Inc. v. General Binding Corp.*, 104 F. Supp.2d 958, 960 (N.D. Ill. 2000) (no commercial offer for sale when meeting lacked discussion of quantity, delivery date or shipment or payment terms, despite discussion of sales price).

To the extent that the terms ordinarily necessary for a commercial offer for sale may have eventually been provided by Mr. O'Connor, they were not provided until at least when Mr. O'Connor sent his written proposal (the Attachmate Letter) to Mr. Buckingham

PATENT
ATTY. DOCKET NO. 11032-2144

on October 30, 1995. However, the Attachmate Letter came after the critical date and, therefore, cannot itself be the basis for establishing an on-sale bar under §102(b).

The Attachmate Letter clearly sets out a new proposal to be considered by Attachmate, rather than confirming a prior offer and acceptance.⁷ For example, Mr. O'Connor introduced a number of new details (details that were not discussed during the prior telephone conversation) by stating "I suggest the following." See Attachmate Letter, page 1 (emphasis added). This is consistent with a proposal being presented for the first time, rather than confirming a set of terms already agreed upon. Indeed, during the prior telephone call, Mr. O'Connor was asked to send a proposal, and he gave Mr. Buckingham the proposal in the Attachmate Letter. See O'Connor R.132 Decl., ¶¶25-26.

Contrary to these facts, the Examiner argues that the transaction was fully discussed during the prior telephone call. According to the Examiner, during the telephone conversation between Mr. O'Connor and Mr. Buckingham, Mr. O'Connor allegedly discussed (a) the ability to target ads to people who were surfing the net, (b) a range of products or services related to Internet advertising that he could provide, (c) software that he could provide that would utilize banner ads and target specified people, job types or accounts in exchange for \$20,000.00, and (d) the ability to provide feedback/reports on advertising; and Mr. Buckingham allegedly "agreed" to become an initial advertising sponsor for targeted advertising. Office Action dated Oct. 24, 2001, pg. 16.

As an initial matter, one of the citations relied upon in the by the Examiner to the Buckingham deposition (page 64, line 17 - page 65, line 14) extracts information from the Attachmate Letter, not necessarily from the prior telephone conversation between Mr. Buckingham and Mr. O'Connor. This distinction is important, because to the extent that any information derives from the Attachmate Letter, such information comes after the critical date and therefore cannot form the basis of a rejection under §102(b).

⁷ In the present case, the Attachmate Letter does not constitute a commercial offer for sale because, as discussed more fully in Section C.3 below, the arrangements made with Attachmate were primarily for experimental purposes.

PATENT
ATTY. DOCKET NO. 11032-2144

Even assuming the accuracy of the facts recited by the Examiner, however, they do not give rise to a commercial offer to sell the invention. Rather, they amount to nothing more than an indefinite and preliminary discussion of sponsorship by Attachmate of a still-developing targeted advertising system. Under *Group One* and the other cases discussed above, such an indefinite and preliminary discussion does not give rise to a commercial offer for sale.

In the Final Rejection (dated Oct. 28, 2002), pg. 8, the Examiner again refers to a discussion of the amount of \$20,000 during the telephone call. However, that discussion only served to indicate the total amount that Attachmate was willing to invest in Internet advertising – indeed, Mr. Buckingham stated that he suggested the amount because his company was under its advertising budget, so he was willing to “throw \$20,000 into this.” Buckingham deposition, pg. 72 lines 10-12. Until the Attachmate Letter was sent, there were no specific details as to what type, number, etc. of advertisements that Attachmate would receive in exchange for the \$20,000 amount.

Furthermore, the discussion of a general dollar amount all and/or desired general characteristics of an advertising system does not mean that a commercial offer for sale occurred. See *Linear Technology Corp. v. Micrel, Inc.*, 275 F.3d 1040, 1049-52, 61 U.S.P.Q.2d 1225, 1230-32 (Fed. Cir. 2001) (no on sale bar despite occurrence of activities such as: communications about pricing information with distributors and sales representatives, including at least one discussion with a potential customer; and publication and communication of preliminary data sheets and promotional information); *D&K Int'l*, 104 F. Supp.2d at 960 (meeting that included discussion of sales price but not quantity, delivery date or shipment or payment terms was not sufficient to trigger on-sale bar).

Relying on the Buckingham deposition, the Examiner also alleges in the Final Rejection, pg. 7, that the terms in the Attachmate Letter were previously agreed upon during the prior telephone call. However, Mr. Buckingham acknowledged that he merely assumed that the letter was a recollection of the call. See Buckingham deposition at pg. 59, lines 24-25. Given Mr. Buckingham's lack of memory on many key points – the deposition is filled with acknowledgements by Mr. Buckingham that he could not recall

PATENT
ATTY. DOCKET NO. 11032-2144

any discussion of details (see, e.g., Buckingham deposition at pp. 42, 44-47, 58, 62) – there is nothing to establish that any terms were “agreed” to in the prior telephone call.

Further, if such “terms” had already been agreed upon in the prior telephone call, as alleged by the Examiner, it would have made no sense for Mr. O’Connor to introduce these points in the letter by stating “I suggest.” See Attachmate Letter, pg. 1. Rather, if the specific terms introduced in the Attachmate Letter had in fact been discussed and agreed to in the prior telephone call, Mr. O’Connor would have stated in the letter that these points were already agreed upon – but that is clearly not the case. Rather, the Attachmate Letter itself shows that it was a proposal being made for the first time and was not confirming a prior oral agreement.⁸

2. The Invention Was Not Ready For Patenting Prior To The Critical Date

To be ready for patenting, the invention must be “complete” rather than “substantially complete.” *Pfaff*, 525 U.S. at 66, 119 S. Ct. at 311, 48 U.S.P.Q.2d at 1646. In distinguishing a “complete” invention from one still in the “experimental phase,” 525 U.S. at 66 n. 12, 119 S. Ct. at 311 n.12, 48 U.S.P.Q.2d at 1646 n.12, the Supreme Court clearly announced that an invention that is still undergoing experimentation or testing is not “complete” and, therefore, cannot be ready for patenting. As discussed more fully in section C.3 below (experimental use), the present invention was undergoing development by the inventors at the time of the alleged sale; after the critical date the inventors were still developing the invention and they conducted substantial testing for several months thereafter. Thus, under *Pfaff*, the invention was not ready for patenting prior to the critical date.

Moreover, the arguments presented by the Examiner do not establish that the present invention was ready for patenting prior to the critical date. In the Office Action dated Oct. 24, 2001, the Examiner did not present any argument or evidence at all that the claimed invention was ready for patenting at the time of the alleged offer for sale.

⁸ Indeed, Mr. Buckingham acknowledged that he may have invited Mr. O’Connor to submit a proposal. See Buckingham deposition, page 72, lines 15-20.

PATENT
ATTY. DOCKET NO. 11032-2144

Later, in the Final Rejection (dated Oct. 28, 2002), the Examiner attempted to present several arguments directed to this issue but, as discussed below, each of the arguments was based on a clear misapprehension of the facts.

First, the Examiner asserts that Applicants filed the patent application less than one week after the alleged sale took place, and that the filing of an application within such close proximity to the alleged sale constitutes ready for patenting. Final Rejection at 6. However, the application was filed on October 29, 1996, approximately a year after the alleged offer for sale took place (rather than within a week). Accordingly, as the Examiner's assertion is based upon a clear mistake, this argument lacks merit.

The Examiner next asserts in the Final Rejection (page 6) that, according to the deposition testimony of Mr. Buckingham, Kevin O'Connor told Mr. Buckingham that IAN could target ads based on, *inter alia*, utilization of AdJump. This argument, too, is based on a mistaken understanding of the facts. As demonstrated by the brief discussion of AdJump in the Attachmate letter (at page 1, paragraph 2), Mr. O'Connor was referring to tracking ad click-through activity of viewers of *non-targeted* ads -- which information was then going to be used in the future, after the non-targeted ads were placed, to determine an appropriate targeting profile. As stated in paragraph 3 of the Attachmate letter, the targeting software was not complete at the time of the letter (Oct. 30, 1995) -- which is confirmed by the Rule 132 declaration of Dwight Merriman (see paragraphs 36-37 stating that the minimal amount of code necessary for the ad server to serve targeted third-party ads was not completed until December 1995).

Next, the Examiner refers to discussion in the Attachmate Letter about targeting of ads in the present tense and deployment of "enhancements i.e., IAF within 2-3 weeks." Final Rejection, pp. 6-7. Again, the Examiner's argument is based on a mistaken understanding of the facts.⁹ As set forth in the Attachmate Letter (page 1), IAF refers to "Internet Address Finder," an "adjunct" service that was to supply an e-mail address directory (an Internet "white pages"). This service did not involve serving ads of any kind

⁹ And, as set forth above, the Attachmate Letter was sent after the critical date, and thus cannot by itself be used to establish an on-sale bar.

PATENT
ATTY. DOCKET NO. 11032-2144

(whether targeted or untargeted), and therefore has no bearing whatsoever on whether the claimed invention was ready for patenting.

Furthermore, mere mention of the concept of ad targeting in the telephone conversation or the subsequent letter does not establish that the invention was ready for patenting. See *Space Systems/Loral, Inc. v. Lockheed Martin Corp.*, 271 F.3d 1076, 1081 Fed. Cir. 2001) ("The fact that a concept is eventually shown to be workable does not retroactively convert the concept into one that was "ready for patenting' at the time of conception."),¹⁰

3. Experimental Use Negates the On-Sale Bar

Finally, the transaction that was the subject of the Attachmate Letter (and alleged to have taken place during the prior telephone call) was primarily for experimental purposes, and the invention remained under development and testing well after the critical date. It is well-established that experimental use negates application of the public use/on-sale bar under §102(b). *EZ Dock, Inc. v. Schafer Systems, Inc.*, 276 F.3d 1347, 1351-52 (Fed. Cir. 2002). As the Supreme Court recognized in *Pfaff*:

[A]n inventor who seeks to perfect his discovery may conduct extensive testing without losing his right to obtain a patent for his invention – even if such testing occurs in the public eye. The law has long recognized the distinction between inventions put to experimental use and products sold commercially.

Pfaff, 525 U.S. at 64, 119 S. Ct. at 310, 48 U.S.P.Q.2d at 1645. Indeed, experimental use is not a "defense" or "exception" to the on sale bar. Rather, if the on-sale bar is to apply, the transaction must not have been primarily for purposes of experimentation. *Allen Engineering Corp. v. Bartell Industries, Inc.*, 299 F.3d 1336, 1352 (Fed. Cir. 2002) (citing *Pfaff*, 525 U.S. at 67). And, as discussed above in Section C.2, under *Pfaff* an

¹⁰ Compare *Robotic Vision Systems, Inc. v. View Engineering, Inc.*, 249 F.3d 1307, 1312 (Fed. Cir. 2001) (ready for patenting test does not require absence of uncertainty on the part of the inventor concerning the workability of the invention prior to reduction to practice).

PATENT
ATTY. DOCKET NO. 11032-2144

invention is not complete, and therefore not ready for patenting, if it is still in the experimental phase.

Evidence of experimental use includes testing needed to convince the inventor that the invention will work for its intended purpose in its intended environment. *EZ Dock*, 276 F.3d at 1352. Determining whether a transaction is not primarily for purposes of experimentation involves an assessment of the circumstances surrounding the transaction, *Allen Engineering*, 299 F.3d at 1352-53, considering a number of factors (some of which may not apply in any particular case) including:

(1) the necessity for public testing, (2) the amount of control over the experiment retained by the inventor, (3) the nature of the invention, (4) the length of the test period, (5) whether payment was made, (6) whether there was a secrecy obligation, (7) whether records of the experiment were kept, (8) who conducted the experiment, . . . (9) the degree of commercial exploitation during testing[,] . . . (10) whether the invention reasonably requires evaluation under actual conditions of use, (11) whether testing was systematically performed, (12) whether the inventor continually monitored the invention during testing, and (13) the nature of contacts made with potential customers.

Allen Engineering, 299 F.3d at 1353 (citing *EZ Dock*, 276 F.3d at 1357 (Linn, J., concurring)).

Evaluation of the alleged sale and the state of development of the present invention in light of these factors demonstrates that the purpose of the transaction was primarily for experimental purposes, and the invention remained in the experimental phase for several months after the critical date, as discussed below.

(a) Necessity for public testing:

The present invention is directed to technology for third-party ad serving over the Internet – a publicly-accessible network with a multitude of web sites. In order to determine whether the invention would work for its intended purpose in its intended environment, the inventors had to test the ability to serve third-party ads over the Internet upon request from users who are viewing web sites, in real time. *Merriman R.132 Decl.*, ¶¶23, 42, 46-47. For example, during the period of testing in January,

PATENT
ATTY. DOCKET NO. 11032-2144

1996, the inventors planned to test targeting and frequency control, which needed to be performed "live" over the Internet; similarly, they planned a stress test to determine ability to satisfy demand. Merriman R.132 Decl., ¶42.

Indeed, as explained by Christian Knott, an independent Internet and computer technology consultant retained by DoubleClick, the present invention is a complex system highly dependent on Internet connectivity for its operation. For example, when the system is accessed, the system attempts to recognize the Internet Protocol (IP) address of the user whose system requests the ad, and it may attempt to access public databases to obtain further information about the user's network, including determining the domain name corresponding to the user's IP address, all of which depends upon Internet connectivity. Using this information, the system attempts to determine the geographic region, and the size and type of the company through which the user is accessing the Internet, and such information may be stored and used for selecting (targeting) ads for the user. Expert Report of Christian Knott ("Knott Report"), ¶¶14-16.¹¹ Furthermore, the invention must operate across disparate nodes on the Internet, nodes that are under the control of others and that have differing hardware and software implementations. Thus, the non-uniformity of nodes (including those of content providers and users) created a need to test the invention in the "real world" Internet environment. Knott Report, ¶¶17-19.

In addition, to work for its intended purpose, the system serving ads from a site different from those sites hosting desired content pages (into which the ad would be inserted) had to select and deliver ads in a quick and effective manner. And, once the ad is displayed, click-through of the ad – which takes the user to the ad-server rather than directly to the advertiser site – also requires quick and effective communications between sites over the Internet. Determining whether the invention would work in this environment required testing the ad serving technology over the Internet. Tools later

¹¹ The Knott Report was initially prepared and submitted during the prior federal court litigation involving the issued '061 patent. A copy of this report, along with certain other documents from the litigation, was submitted to the PTO in connection with the instant reissue application.

PATENT
ATTY. DOCKET NO. 11032-2144

developed that might have permitted testing in a closed network environment did not exist at the time. Knott Report, ¶¶20-23.

Finally, review of the Attachmate Letter confirms the experimental nature of the proposed arrangements. For example, the letter states that IAN (the inventors' company) would be "using IAF as the first test web site for IAN" and that this test web site would be used to contribute information used to help develop ad targeting techniques. Attachmate Letter, pg. 1 (4th paragraph from top of page, emphasis added). This was the web site on which ads contemplated by the arrangement with Attachmate would be placed. Additionally, as discussed above, the letter refers to use of information from click-throughs to help develop a targeting profile, since the targeting software was still being developed. Attachmate Letter, pg. 1 (numbered paragraphs 2-3).

Accordingly, testing of the ad serving technology using the Internet was required. See generally, Knott Report, ¶¶13-24.

(b) Amount of control over the experiment retained by the inventor:

The inventors through their company conducted all of the testing of their ad serving technology, and therefore retained control over all experimentation. Merriman R.132 Decl., ¶¶39-40, 42, 44, 46.

(c) Nature of invention:

As discussed above, the present invention is directed to technology for third-party ad serving over the Internet. To determine whether the invention would work for its intended purpose on the Internet, the inventors had to test the ability to serve third-party ads over the Internet upon request from users who are viewing web sites, in real time. Merriman R.132 Decl., ¶¶23, 42, 46-47. See also discussion in section C.3(a) (Necessity for public testing) above.

(d) Length of the test period:

Testing of the third party ad serving technology took place over a period of about 3 to 4 months, beginning in December 1995 and continuing through the beta test in March 1996. Merriman R.132 Decl., ¶¶39-40, 42-44, 46.

PATENT
ATTY. DOCKET NO. 11032-2144

(e) Payment:

The payment involved with the transaction at issue was not set according to any established commercial market for targeted ads serving. Indeed, one-half of the amount (\$10,000) was for hard-coded, nontargeted ads. Attachmate Letter at pg. 1 (numbered paragraph 2); O'Connor R.132 Decl., ¶¶27. The balance of the amount (\$10,000) was proposed to be set aside for targeted ads; such that IAN would determine in the future the most effective way to spend the balance for targeted ads, in accordance with favorable pricing to Attachmate. Attachmate Letter at pg. 1 (numbered paragraph 3); O'Connor R.132 Decl., ¶¶27. The Attachmate Letter (pg. 1, numbered paragraph 3) refers to a "draft" rate sheet having ad rates for targeted advertising, indicating that there was no established commercial rate at the time, and the reference to "favorable" pricing clearly indicates that Attachmate would be getting below-market rates in any event.

(f) Secrecy obligation:

The transaction was to remain confidential until such time as there was a public announcement of IAN. Attachmate Letter, pg. 2 (numbered paragraph 6).

(g) Who conducted the experiment:

As set forth above, the inventors through their company conducted all testing of their ad serving technology. Merriman R.132 Decl., ¶¶39-40, 42, 44, 46.

(h) Degree of commercial exploitation during testing:

Examination of the state of development of the ad serving technology and the testing that was ongoing confirms that there was no commercial exploitation of the invention during the period in which the Attachmate project was carried out. At the time the Attachmate Letter was sent (October 1995) and continuing into early 1996, Mr. Merriman, one of the co-inventors, was developing the necessary ad serving software. Merriman R.132 Decl., ¶¶36-37. The first test of targeted ad serving was not done until December 1995, and test ads served for one of the test customers, ISS, was done without receiving any money for serving the ads. Merriman R.132 Decl., ¶¶38-39, 46;

PATENT
ATTY. DOCKET NO. 11032-2144

O'Connor R.132 Decl., ¶31. Testing of the targeted ad serving technology continued into January 1996, and beta-testing began in March of 1996. Merriman R.132 Decl., ¶¶40-44, 47; O'Connor R.132 Decl., ¶32. The commercial launch of DoubleClick's ad serving technology did not take place until April 1996. Merriman R.132 Decl., ¶44.

(i) Invention reasonably requires evaluation under actual conditions of use:

As discussed above, the present invention is directed to technology for third-party ad serving over the Internet. To determine whether the invention would work for its intended purpose on the Internet, the inventors had to test the ability to serve third-party ads over the Internet upon request from users who are viewing web sites, in real time. Merriman R.132 Decl., ¶¶23, 42, 46-47. See also discussion in section C.3(a) (Necessity for public testing) above.

(j) Testing systematically performed:

Initial testing by the inventors showed that the concept could work, and once the software was developed, the inventors through their company conducted beta testing. Merriman R.132 Decl., ¶¶38, 42-44.

(k) Monitoring of the invention during testing:

As set forth above, the inventors through their company conducted all testing of their ad serving technology and observed the results of their testing. Merriman R.132 Decl., ¶¶39-40, 42, 44, 46. Indeed, with respect to the transaction at issue, the Attachmate Letter shows that the inventors were monitoring results of even nontargeted ads to help develop a targeting profile. See Attachmate Letter, pg. 1 (numbered paragraphs 2-3).

(l) Nature of contacts made with potential customers:

Prior to launch, the inventors through their company ran testing of their third party ad serving technology. Merriman R.132 Decl., ¶¶39-40, 42, 44, 46. During testing in early 1996, the inventors through their company began soliciting web sites to participate in the beta test. Merriman R.132 Decl., ¶43. The commercial launch of

PATENT
ATTY. DOCKET NO. 11032-2144

DoubleClick's ad serving technology did not take place until April 1996, after the beta test, Merriman R.132 Decl., ¶44.

Upon consideration of all the relevant factors discussed above, the conclusion that the transaction proposed in the Attachmate Letter was primarily for experimental purposes is inescapable.


In sum, Applicants respectfully submit that the events prior to the critical date do not trigger the on-sale bar under §102(b) and, therefore, request that this rejection be overruled.

CONCLUSION

Applicants respectfully submit that claims 1-57 are allowable and request reversal of all of the rejections.

Respectfully submitted,

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PATENT
ATTY. DOCKET NO. 11032-2144

CLAIMS

1. (Four Times Amended) A network supporting the hypertext transfer protocol, comprising:

a user node having a browser program coupled to said network, said user node providing requests for information on said network;

a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content, advertising space for display of advertising content and a link message to said user node;

an advertiser node having an advertiser web site including advertising content, said advertiser node responsive to a request to provide said advertising content; and

an advertisement server node storing information about said user node, said advertisement server node being responsive to a request from said user node based on said link message to select [an] said advertiser node as a selected advertiser node based upon the information stored about said user node at said advertisement server node, and identify said advertiser node as said selected advertiser node to said user node,

whereby said advertising content from said selected advertiser node is displayed at said user node in response to a request sent from said user node to said advertiser node to provide said advertising content.

2. (Amended) A network in accordance with claim 1, wherein said advertisement server node selects said advertiser node based on [the] a number of times said advertising content has been previously displayed at said user node.

3. (Amended) A network in accordance with claim 1, wherein said advertisement server node selects said advertiser node based on [the] characteristics of [said] a user.

4. (Original) A network in accordance with claim 3, wherein said advertisement server node selects said advertiser node based on at least one of the characteristics of said user selected from the group consisting of user ID, IP address, user cookie, user login code, user digital certificate, geographic location, time zone, country, domain type, Internet service provider, organization type, employer, industry type, company size,

PATENT
ATTY. DOCKET NO. 11032-2144

number of employees, types of advertisements previously viewed and types of advertisements previously clicked.

5. (Original) A network in accordance with claim 1, wherein said link message is an HTML tag.

6. (Original) A network in accordance with claim 1, wherein said link message is an HTTP redirect message containing an IP address used to redirect said user node to said advertisement server node.

7. (Four Times Amended) In a network supporting the hypertext transfer protocol and having a user node including a browser program coupled to said network, said user node providing requests for information on said network, a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content, advertising space for display of advertising content and a link message to said user node, a plurality of advertiser nodes, each of said plurality of advertiser nodes having a respective advertiser web site including respective advertising content, each of said advertiser nodes responsive to a respective request to provide respective advertising content, a network node comprising:

an advertisement server node storing information about said user node and responsive to a request from said user node based on said link message to select [an] one of said plurality of advertiser [node] nodes as a selected advertiser node based upon the information stored about said user node at said advertisement server node, and identify said advertiser node as said selected advertiser node to said user node, whereby said advertising content from said selected advertiser node is displayed at said user node in response to a request sent from said user node to said advertiser node to provide said advertising content.

8. (Amended) [An advertisement server] A network node in accordance with claim 7, wherein said advertisement server node selects said advertiser node based on [the] a number of times said advertising content has been previously displayed at said user node.

PATENT
ATTY. DOCKET NO. 11032-2144

9. (Amended) [An advertisement server] A network node in accordance with claim 7, wherein said advertisement server node selects said advertiser node based on [the] characteristics of [said] a user.

10. (Amended) [An advertisement server] A network node in accordance with claim 9, wherein said advertisement server node selects said advertiser node based on at least one of the characteristics of said user selected from the group consisting of user ID, IP address, user cookie, user login code, user digital certificate, geographic location, time zone, country, domain type, Internet service provider, organization type, employer, industry type, company size, number of employees, types of advertisements previously viewed and types of advertisements previously clicked.

11. (Original) A network node in accordance with claim 7, wherein said link message is an HTML tag.

12. (Original) A network node in accordance with claim 7, wherein said link message is an HTTP redirect message containing an IP address used to redirect said user node to said advertisement server node.

13. (Four Times Amended) In a network supporting the hypertext transfer protocol and having a user node including a browser program coupled to said network, said user node providing requests for information on said network, an advertiser node having an advertiser web site including advertising content, said advertiser node responsive to a request to provide said advertising content, and an advertisement server node storing information about said user node and responsive to a request from said user node to select [an] said advertiser node as a selected advertiser node based upon the information stored about said user node at said advertisement server node, and identify said advertiser node as said selected advertiser node to said user node, wherein said advertising content from said selected advertiser node is displayed at said user node in response to a request sent from said user node to said advertiser node to provide said advertising content, a network node comprising:

a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content and advertising

PATENT
ATTY. DOCKET NO. 11032-2144

space for display of advertising content, said content provider affiliate web site further providing a link message to said user node identifying the IP address of said advertisement server node to said user node for providing advertising content for said advertising space, wherein the advertising content is selected by said advertisement server node based upon the information stored about said user node at said advertisement server node.

14. (Original) A network node in accordance with claim 13, wherein said link message is an HTML tag.

15. (Original) A network node in accordance with claim 13, wherein said link message is an HTTP redirect message containing said IP address used to redirect said user node to said advertisement server node.

16. (Three Times Amended) A network supporting the hypertext transfer protocol, comprising:

a user node having a browser program coupled to said network, said user node providing requests for information on said network;

a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content, advertising space for display of advertising content and a link message to said user node; and

an advertisement server node storing information about said user node and responsive to a request from said user node based on said link message to select an advertising banner for said advertising space based upon the information stored about said user node, and to reply to said request from said user node by identifying said advertising banner to said user node,

whereby said advertising banner from said advertisement server node is displayed at said user node in said advertising space.

17. (Amended) [An advertisement server node] A network in accordance with claim 16, wherein said advertisement server node selects said advertiser node based on [the] a number of times said advertising content has been previously displayed at said user node.

PATENT
ATTY. DOCKET NO. 11032-2144

18. (Amended) [An advertisement server node] A network in accordance with claim 16, wherein said advertisement server node selects said advertiser node based on [the] characteristics of [said] a user.

19. (Amended) [An advertisement server node] A network in accordance with claim 18, wherein said advertisement server node selects said advertiser node based on at least one of the characteristics of said user selected from the group consisting of user ID, IP address, user cookie, user login code, user digital certificate, geographic location, time zone, country, domain type, Internet service provider, organization type, employer, industry type, company size, number of employees, types of advertisements previously viewed and types of advertisements previously clicked.

20. (Three Times Amended) A network in accordance with claim 16 [further including:], wherein said advertisement server node is responsive to a request from said user node to identify an advertiser web site corresponding to said advertising banner; and further including

an advertiser node having an advertiser web site including advertising content corresponding to said advertising banner, said advertiser node responsive to a request to provide said advertising content corresponding to the selection of said advertising banner by [said] a user,

whereby said advertising content from said advertiser node is displayed at said user node in response to a request sent from said user node to said advertiser node to provide said advertising content.

21. (Original) A network in accordance with claim 16, wherein said link message is an HTML tag.

22. (Original) A network in accordance with claim 16, wherein said link message is an HTTP redirect message containing an IP address used to redirect said user node to said advertisement server node.

23. (Three Times Amended) In a network supporting the hypertext transfer protocol and comprising a user node having a browser program coupled to said network,

PATENT
ATTY. DOCKET NO. 11032-2144

said user node providing requests for information on said network, a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content, advertising space for display of advertising content and a link message to said user node, a network node comprising:

an advertisement server node storing information about said user node and responsive to a request from said user node based on said link message to select an advertising banner for said advertising space based upon the information stored about said user node at said advertisement server node, and to reply to said request from said user node by identifying said advertising banner to said user node, wherein said advertising banner from said advertisement server node is displayed at said user node in said advertising space.

24. (Amended) [An advertisement server] A network node in accordance with claim 23, wherein said advertisement server node selects said advertising banner based on [the] a number of times said advertising content has been previously displayed at said user node.

25. (Amended) [An advertisement server] A network node in accordance with claim 23, wherein said advertisement server node selects said advertising banner based on [the] characteristics of [said] a user.

26. (Amended) [An advertisement server] A network node in accordance with claim 25, wherein said advertisement server node selects said advertising banner based on at least one of the characteristics of said user selected from the group consisting of user ID, IP address, user cookie, user login code, user digital certificate, geographic location, time zone, country, domain type, Internet service provider, organization type, employer, industry type, company size, number of employees, types of advertisements previously viewed and types of advertisements previously clicked.

27. (Original) A network node in accordance with claim 23, wherein said link message is an HTML tag.

28. (Original) A network node in accordance with claim 23, wherein said link

PATENT
ATTY. DOCKET NO. 11032-2144

message is an HTTP redirect message containing an IP address used to redirect said user node to said advertisement server node.

29. (Twice Amended) In a network supporting the hypertext transfer protocol and comprising a user node having a browser program coupled to said network, said user node providing requests for information on said network, an advertisement server node storing information about said user node and responsive to a request from said user node to select an advertising banner for said advertising space based upon the information stored about said user node, and to reply to said request from said user node by identifying said advertising banner to said user node, a network node comprising:

a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content and advertising space for display of advertising content, said content provider affiliate web site further providing a link message to said user node identifying [the] an IP address of said advertisement server node to said user node for providing an advertising banner for said advertising space, wherein the advertising banner is selected based upon the information stored about said user node at said advertisement server node.

30. (Original) A network node in accordance with claim 29, wherein said link message is an HTML tag.

31. (Original) A network node in accordance with claim 29, wherein said link message is an HTTP redirect message containing said IP address used to redirect said user node to said advertisement server node.

32. (Four Times Amended) In a network supporting the hypertext transfer protocol and comprising a user node having a browser program coupled to said network, said user node providing requests for information on said network, a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content, advertising space for display of advertising content and a link message to said user node, and an advertiser node having an advertiser web site including advertising content corresponding to [said] an advertising banner, said advertiser node responsive to a request to provide said advertising content corresponding

PATENT
ATTY. DOCKET NO. 11032-2144

to the selection of said advertising banner by [said] a user; a network node comprising:
an advertisement server node storing information about said user node and
responsive to a request from said user node based on said link message to select an
advertising banner for said advertising space based upon the information stored about
said user node, and to reply to said request from said user node by identifying said
advertising banner to said user node, wherein said advertisement server node is
responsive to a request from said user node to identify an advertiser web site
corresponding to said advertising banner, whereby said advertising banner from said
advertisement server node is displayed at said user node in said advertising space, and
whereby said advertising content [from said selected advertiser node] corresponding to
the selection of said advertising banner is displayed at said user node in response to a
request sent from said user node to said advertiser node to provide said advertising
content.

33. (Amended) [An advertisement server] A network node in accordance with
claim 32, wherein said advertisement server node selects said advertising banner based
on [the] a number of times said advertising content has been previously displayed at said
user node.

34. (Amended) [An advertisement server] A network node in accordance with
claim 32, wherein said advertisement server node selects said advertising banner based
on [the] characteristics of [said] a user.

35. (Amended) [An advertisement server] A network node in accordance with
claim 34, wherein said advertisement server node selects said advertising banner based
on at least one of the characteristics of said user selected from the group consisting of
user ID, IP address, user cookie, user login code, user digital certificate, geographic
location, time zone, country, domain type, Internet service provider, organization type,
employer, industry type, company size, number of employees, types of advertisements
previously viewed and types of advertisements previously clicked.

36. (Amended) A network method in accordance with claim [35] 42, wherein
said advertisement server node selects said advertising banner based on [the]

PATENT
ATTY. DOCKET NO. 11032-2144

characteristics of [said] a user.

37. (Original) A network method in accordance with claim 36, wherein said advertisement server node selects said advertising banner based on at least one of the characteristics of said user selected from the group consisting of user ID, IP address, user cookie, user login code, user digital certificate, geographic location, time zone, country, domain type, Internet service provider, organization type, employer, industry type, company size, number of employees, types of advertisements previously viewed and types of advertisements previously clicked.

38. (Amended) A network method in accordance with claim [35| 42, wherein said advertisement server node selects said advertising banner based on [the] a number of times said advertising content has been previously displayed at said user node.

39. (Two Times Amended) A method in accordance with claim 37, said method further comprising:

sending a request from said user node to said advertising server web site responsive to selection of said advertising banner at said user node;

sending a reply from said advertising server web site to said user node identifying said advertiser web site corresponding to said advertising banner;

sending a request from said user node to said [advertising] advertiser web site to provide said advertising content corresponding to said selected advertising banner [by said uses];

sending a reply from said advertiser web site to said user node; and

displaying said advertising content at said user node.

40. (Original) A network node in accordance with claim 32, wherein said link message is an HTML tag.

41. (Original) A network node in accordance with claim 32, wherein said link message is an HTTP redirect message containing an IP address used to redirect said user node to said advertisement server node.

42. (Amended) In a network supporting the hypertext transfer protocol and

PATENT
ATTY. DOCKET NO. 11032-2144

including a user node having a browser program coupled to said network, a content provider affiliate node having a respective affiliate web site containing media content, advertising space for display of advertising content and an advertisement server node having an advertising server web site and storing information about said user node, a method for delivery of advertising to said user node, said method comprising:

 sending a request for information from said user node to said affiliate web site requesting information;

 sending a reply from said affiliate web site responsive to said request for information from said user node, said reply containing media content, advertising space for display of advertising content and a link message to said user node;

 sending a request from said user node based on said link message to said advertising server web site to provide an advertising banner for said advertising space;

 selecting, at said advertising server web site, an advertising banner based upon the information stored about said user node;

 sending a reply from said advertising server web site identifying said advertising banner to said user node; and

 displaying said advertising banner in said advertising space at said user node.

43. (Original) A network method in accordance with claim 42, wherein said link message is an HTML tag.

44. (Original) A network method in accordance with claim 42, wherein said link message is an HTTP redirect message containing an IP address used to redirect said user node to said advertisement server node.

45. (Amended) In a network supporting the hypertext transfer protocol and including a user node having a browser program coupled to said network, a content provider affiliate node having a respective affiliate web site containing media content and advertising space for display of advertising content, an advertisement server node storing information about said user node, and an advertiser node having an advertiser web site including advertising content, a method for delivery of advertising content to said user node said method comprising:

PATENT
ATTY. DOCKET NO. 11032-2144

sending a request for information from said user node to said affiliate web site requesting information;

sending a reply from said affiliate web site, responsive to said request for information from said user node, containing media content, advertising space for display of advertising content and a link message to said user node;

sending a request based on said link message from said user node to said advertisement server node to select an advertiser node;

selecting, at said advertisement server node, an advertiser node based upon the information stored about said user node;

sending a reply from said advertisement server node to said user node identifying said selected advertiser node;

sending a request from said user node to said advertiser node to provide said advertising content to said user;

sending a reply from said advertiser web site to said user node containing said advertising content; and

displaying said advertising content at said user node.

46. (Amended) A network method in accordance with claim 45, wherein said advertisement server node selects said advertiser node based on [the] a number of times said advertising content has been previously displayed at said user node.

47. (Amended) A network method in accordance with claim 45, wherein said advertisement server node selects said advertiser node based on [the] characteristics of [said] a user.

48. (Original) A network method in accordance with claim 47, wherein said advertisement server node selects said advertiser node based on at least one of the characteristics of said user selected from the group consisting of user ID, IP address, user cookie, user login code, user digital certificate, geographic location, time zone, country, domain type, Internet service provider, organization type, employer, industry type, company size, number of employees, types of advertisements previously viewed and types of advertisements previously clicked.

PATENT
ATTY. DOCKET NO. 11032-2144

49. (Original) A network method in accordance with claim 45, wherein said link message is an HTML tag.

50. (Original) A network method in accordance with claim 45, wherein said link message is an HTTP redirect message containing an IP address used to redirect said user node to said advertisement server node.

51. (Twice Amended) A network comprising:

a user node having a browser program coupled to said network, said user node providing requests for information on said network;

a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content, advertising space for display of advertising content and a link message to said user node;

an advertiser node having an advertiser web site including advertising content, said advertiser node responsive to a request to provide said advertising content; and an advertisement server node responsive to a request from said user node based on said link message to select said advertiser node as a selected advertiser node, and identify said advertiser node as said selected advertiser node to said user node,

whereby said advertising content from said selected advertiser node is displayed at said user node in response to a request sent from said user node to said advertiser node to provide said advertising content,

wherein said advertisement server node selects said advertiser node based on a number of times said advertising content has been previously displayed at said user node.

52. (Twice Amended) In a network having a user node including a browser program coupled to said network, said user node providing requests for information on said network, a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content, advertising space for display of advertising content and a link message to said user node, a plurality of advertiser nodes, each of said plurality of advertiser nodes having a respective advertiser web site including respective advertising content, each of said advertiser nodes responsive to a respective request to provide respective advertising

PATENT
ATTY. DOCKET NO. 11032-2144

content, a network node comprising:

an advertisement server node responsive to a request from said user node based on said link message to select one of said plurality of advertiser nodes as a selected advertiser node, and identify said advertiser node as said selected advertiser node to said user node, whereby said advertising content from said selected advertiser node is displayed at said user node in response to a request sent from said user node to said advertiser node to provide said advertising content.

wherein said advertisement server node selects said advertiser node based on a number of times said advertising content has been previously displayed at said user node.

53. (Twice Amended) A network comprising:

a user node having a browser program coupled to said network, said user node providing requests for information on said network;

a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content, advertising space for display of advertising content and a link message to said user node; and

an advertisement server node responsive to a request from said user node based on said link message to select an advertising banner for said advertising space, and to reply to said request from said user node by identifying said advertising banner to said user node.

whereby said advertising banner from said advertisement server node is displayed at said user node in said advertising space.

wherein said advertisement server node selects said advertiser node based on a number of times said advertising content has been previously displayed at said user node.

54. (Twice Amended) In a network comprising a user node having a browser program coupled to said network, said user node providing requests for information on said network, a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content, advertising space for display of advertising content and a link message to said user node, a network node comprising:

an advertisement server node responsive to a request from said user node based

PATENT
ATTY. DOCKET NO. 11032-2144

on said link message to select an advertising banner for said advertising space, and to reply to said request from said user node by identifying said advertising banner to said user node, wherein said advertising banner from said advertisement server node is displayed at said user node in said advertising space,

wherein said advertisement server node selects said advertising banner based on a number of times said advertising content has been previously displayed at said user node.

55. (Twice Amended) In a network comprising a user node having a browser program coupled to said network, said user node providing requests for information on said network, a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content, advertising space for display of advertising content and a link message to said user node, and an advertiser node having an advertiser web site including advertising content corresponding to an advertising banner, said advertiser node responsive to a request to provide said advertising content corresponding to the selection of said advertising banner by a user, a network node comprising:

an advertisement server node responsive to a request from said user node based on said link message to select an advertising banner for said advertising space, and to reply to said request from said user node by identifying said advertising banner to said user node, wherein said advertisement server node is responsive to a request from said user node to identify an advertiser web site corresponding to said advertising banner, whereby said advertising banner from said advertisement server node is displayed at said user node in said advertising space, and whereby said advertising content corresponding to the selection of said advertising banner is displayed at said user node in response to a request sent from said user node to said advertiser node to provide said advertising content,

wherein said advertisement server node selects said advertising banner based on a number of times said advertising content has been previously displayed at said user node.

56. (Previously Presented) In a network including a user node having a browser program coupled to said network, a content provider affiliate node having a respective affiliate web site containing media content, advertising space for display of advertising

PATENT
ATTY. DOCKET NO. 11032-2144

content and an advertisement server node having an advertising server web site, a method for delivery of advertising to said user node, said method comprising:

sending a request for information from said user node to said affiliate web site requesting information;

sending a reply from said affiliate web site responsive to said request for information from said user node, said reply containing media content, advertising space for display of advertising content and a link message to said user node;

sending a request from said user node based on said link message to said advertising server web site to provide an advertising banner for said advertising space;

selecting, at said advertising server web site, an advertising banner;

sending a reply from said advertising server web site identifying said advertising banner to said user node; and

displaying said advertising banner in said advertising space at said user node,

wherein said advertisement server node selects said advertising banner based on a number of times said advertising content has been previously displayed at said user node.

57. (Twice Amended) In a network including a user node having a browser program coupled to said network, a content provider affiliate node having a respective affiliate web site containing media content and advertising space for display of advertising content, an advertisement server node, and an advertiser node having an advertiser web site including advertising content, a method for delivery of advertising content to said user node said method comprising:

sending a request for information from said user node to said affiliate web site requesting information;

sending a reply from said affiliate web site, responsive to said request for information from said user node, containing media content, advertising space for display of advertising content and a link message to said user node;

sending a request based on said link message from said user node to said advertisement server node to select an advertiser node;

selecting, at said advertisement server node, an advertiser node;

sending a reply from said advertisement server node to said user node identifying said selected advertiser node;

PATENT
ATTY. DOCKET NO. 11032-2144

sending a request from said user node to said advertiser node to provide said
advertising content to said user;

sending a reply from said advertiser web site to said user node containing said
advertising content; and

displaying said advertising content at said user node,

wherein said advertisement server node selects said advertiser node based on a
number of times said advertising content has been previously displayed at said user node.